

## REMARKS

This Reply is submitted along with a Request for Continued Examination in response to an Office Action dated July 29, 2003. The Request and the present Reply are timely filed and the proper fees are enclosed. Entry and consideration hereof are requested.

In the outstanding Office Action, the Examiner rejects all of the pending claims on prior art grounds. Particularly, claims 12-14 and 17-26 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,843,958 to Egosi in view of U.S. Design Patent No. 349,571 to Merritt; claims 12-15, 18-20, 22, 27, and 29-37 are rejected under §103(a) as being obvious over U.S. Patent No. 5,655,453 to Ackley in view of Merritt; claim 16 is rejected for obviousness in view of Ackley, Merritt and U.S. Patent No. 5,142,976 to Roulleau; claims 27-32 and 34-37 are further rejected under §103 as being obvious in view of Egosi, Merritt, and U.S. Patent No. 5,831,641 to Carlson; and claims 38-39 are rejected for obviousness with respect to Rolleau and Merritt.

The Examiner's various rejections are now addressed in turn.

Firstly, it is noted that for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success,

determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

As mentioned above, claims 12-14 and 17-26 are presently rejected as being obvious with respect to the combination of Egosi and Merritt.

With regard to claim 12, Applicant submits that the outstanding obviousness rejection is improper and may not be maintained because none of the above-mentioned requirements for establishing *prima facie* obviousness are found in the Examiner's proposed combination.

Claim 12 recites a process for forming a pattern on an earplug comprising, *inter alia*, providing an earplug, orienting the earplug relative to a printing device, and printing the pattern on the earplug using the printing device.

Turning to Egosi, a method and apparatus are disclosed for applying *advertisements* to *eggs*. The advertisements are applied to the eggs E by advertisement dispensing means 56 included in an egg candling and grading machine. Col. 2, line 67 – col. 3, line 25, and Figure 2. The eggs E are brought proximate the advertisement dispensing means 56 by a conveyor 40. Col. 4, lines 11-22. Alternatively, an assembly positions the eggs E proximate the advertisement dispensing means 56, the assembly including a plurality of fingers 84 which grip the eggs E and a carrier/balancing arm 80, 70 capable of pivoting the gripped eggs E toward the advertisement dispensing means 56. Col. 5, lines 4-44 and Figure 5.

Egosi does not teach or suggest providing an *earplug*, orienting the *earplug*, nor printing a pattern on the *earplug*, as recited in claim 12. Further, Egosi is directed to applying an *advertisement* to an *egg*, which is a fragile, edible item with a hard, brittle shell and a aqueous center. Clearly, Egosi does not contemplate printing on earplugs

which are typically compressible resilient items. Thus, undoubtedly, Egosi by itself does not anticipate nor render obvious the claimed invention.

The Examiner has conceded that Egosi does not teach or suggest a printing process for an earplug as claimed but contends Merritt teaches that “an earplug having an indicia provided thereon is well known in the art.” See, Office Action, paragraph 6. The Examiner concludes, it would have been obvious to apply the egg printing process of Egosi to the object shown in Merritt, thus allegedly providing Applicants’ invention.

However, Merritt fails to remedy the deficiencies of Egosi in that Merritt does not specifically disclose an earplug nor a pattern printed on the earplug. Merritt, to the contrary, discloses and claims an ornamental design for a “combination ear protector and cheering aid.” The meaning of “cheering aid” is not understood. The term is not explained in the patent nor is it found in a common dictionary, such as *Oxford Concise English Dictionary 10<sup>th</sup> ed.*, Oxford University Press (1999). The term “ear protector” is clearly vague and non-descriptive and may simply be interpreted as any device which serves to, in some way, shield the ear from exposure to some element or material, etc. This term does not clarify the nature of the claimed design. No other description concerning the design is provided. Instead, only a single drawing is provided. The drawing illustrates an elongated object having a “4” shown at one end thereof. The exact nature, details, and characteristics of the object and the number “4” disposed thereon, are unclear.

Specifically, Merritt does not teach what the number “4” is nor how it is applied to the elongated object. That is, from the disclosure of the reference, it is unclear whether the number “4” is printed, stamped, etched, adhered, or otherwise applied to the elongated object.

Further, while an elongated cylinder-like object is disclosed by Merritt, the size and exact proportions of the object are unknown and, further, the material composing the object and the characteristics thereof are also unknown. In fact, it is unclear as to whether the object disclosed by Merritt is indeed an earplug, as contended by the Examiner. The

design object may not be an earplug at all, and instead could be any item relating to ear protection such as, for example, an ear muff or a portion thereof, a filter or the like for a head phone assembly, an item to protect a user against blows to the ear, an elongate cylindrical pillow to protect the user's ears while sleeping, etc. Clearly, the exact nature, disposition, and character of the object disclosed in Merritt is unclear.

Thus, for at least these reasons, the Examiner's conclusion that Merritt teaches an *earplug* having a *printed* design thereon is unsubstantiated.

Additionally, it is known that drawings alone can anticipate or make obvious a claimed invention but the drawing must show all the claimed structural features and how they are put together. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972); *Jockmus v. Leviton*, 28 F.2d 912 (2d Cir. 1928), emphasis added. Clearly, Merritt does not show *all the claimed structural features and how they are put together* as required by law.

Considering the above, it is abundantly clear that Merritt does not teach or suggest Applicants' process recited in the present claim 12 nor remedy the deficiencies of Egosi discussed above.

Thus, for at least the reasons stated herein, the Egosi and Merritt references, taken singularly or in combination, do not teach or suggest all of the limitations of claim 12. Accordingly, *prima facie* obviousness is not established concerning claim 12 with respect to Egosi and Merritt; reconsideration and withdrawal of the pertinent obviousness rejection is respectfully requested.

Further, even assuming that all the elements of Applicants' claim 12 are disclosed in the Egosi and Merritt references, the Examiner cannot establish obviousness by locating references which only describe various aspects of applicants' invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what applicants have done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat.

App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Here, considering that the main reference, Egosi, does not even allude to printing on earplugs or, for that matter, considering that Egosi does not allude to printing on any type of hearing protection or safety equipment whatsoever, clearly, the required suggestion or motivation to combine and/or modify the Egosi and Merritt references is notably *absent*. Moreover, as discussed above, Egosi is directed toward printing on eggs. As is commonly known, eggs include a hard but brittle outer shell which contains a liquid/aqueous center. Egosi is specifically directed toward the complications surrounding printing on a hard surface of a fragile, edible object. Egosi clearly does not contemplate printing on compressibly resilient items such as earplugs, as claimed by Applicants. Therefore, no suggestion or motivation to apply the printing process Egosi to the object of Merritt is found in the references or in the art. In fact, to modify Egosi as such would be to depart from its intention, which is simply to apply advertisements to brittle, fragile edible eggs.

Finally, considering that the Egosi and Merritt references fail to teach or suggest all of the limitations of claim 12 and considering that there exists no suggestion to modify or combine the references, one of ordinary skill in the art would not have had a reasonable expectation of success in forming the invention recited in claim 12 by modifying the references as suggested by the Examiner.

Thus, none of the requirements for *prima facie* obviousness are met concerning claim 12 with regards to the Egosi and Merritt references; reconsideration and withdrawal of the outstanding obviousness rejection is respectfully requested.

Claims 13, 14, and 17-26 variously depend from claim 12 and are thus correspondingly non-obvious with respect to Egosi and Merritt; reconsideration and withdrawal of all relevant outstanding rejections is requested.

As mentioned initially, claims 12-15, 18-20, 22, 27, and 29-37 are rejected under 35 U.S.C. §103(a) as being obvious in view of Ackley and Merritt.

Again with regard to claim 12, Applicants submit that the outstanding obviousness rejection is improper and may not be maintained because *prima facie* obviousness does not exist, i.e. the Ackley and Merritt references, taken singularly or in combination: (1) fail to teach or suggest all of the recited claim limitations; (2) do not suggest or motivate combining and modifying the references as suggested by the Examiner; and (3) do not offer a reasonable expectation of success in forming Applicants invention.

Ackley teaches a method and apparatus for marking pellet shaped articles. The reference specifically addresses applying marking to irregularly shaped fragile pellet shaped articles of the food and pharmaceutical industries such as candies, capsules, pills, tablets, etc. Col. 2, line 62 through Col. 3, line 26 and Col. 4, lines 48-59. Ackley combines an ink-jet system with a pellet-conveying system especially configured to properly locate and maintain the pellet-shaped articles in proper position as they traverse the ink-jet system. Col. 3, lines 35-42.

It is noted with particular emphasis that Ackley does not teach or suggest providing an earplug, orienting the earplug, nor printing a pattern on the earplug, as recited in Applicant's claim 12. Further, it is noted that the reference is limited to non-impact printing (e.g., ink-jet printing) and does not teach or suggest impact printing techniques as recited in Applicants' claim 15. Additionally, as mentioned, Ackley is directed to fragile, irregularly pellet shaped food and pharmaceutical items. These are typically hard, non-resilient, non-compressible, often hollow objects filled with solid, granular, or liquidous materials. Clearly, Ackley does not contemplate printing on earplugs which are typically compressible, resilient items formed of material such as rubber, foam, etc. Thus, undoubtedly, Ackley fails to teach or suggest all of the limitations of Applicants' claim 12.

Further, Merritt fails to teach or suggest the limitations of claim 12 and additionally fails to remedy the deficiencies of Ackley. (See discussion above concerning Merritt.)

Accordingly, Ackley and Merritt, taken singularly or in combination do not teach or even suggest all of the limitations of independent claim 12. Therefore, *prima facie* obvious is not found with regard to Ackley and Merritt; withdrawal of the relevant rejection is requested.

Further, as discussed, Ackley is directed to marking small, hard, fragile, irregularly pellet shaped articles such as candies, pills, capsules, etc. There is nothing contained in the reference or in the art which would motivate one of ordinary skill in the art to modify Ackley to apply printing to earplugs, which are typically compressibly, resilient items possessing unique and specific printing and handling characteristics. Therefore, again, *prima facie* obviousness does not exist.

Additionally, because Ackley and Merritt fail to teach all of the recited limitations and because there is no suggestion or motivation to combine and modify the references, one of ordinary skill in the art would not have a reasonable likelihood of success of forming Applicants' claimed invention. Thus, again, *prima facie* obviousness is not found.

Accordingly, claim 12 is non-obvious with respect to the Ackley and Merritt references; withdrawal of the outstanding §103 rejection is requested. Claim 12 is not further rejected or objected to and is thus allowable to Applicants.

Claims 13-15, 18-20, and 22 variously depend from allowable claim 12 and are thus allowable; withdrawal of all pertinent outstanding rejections is requested.

Concerning independent claim 27, a process for forming a pattern on an earplug is recited comprising, essentially, all of the limitations of claim 12 and additional limitations. Thus, for at least the reasons submitted with respect to claim 12, claim 27 is non-obvious in view of Ackley and Merritt; withdrawal of the outstanding §103 rejection is requested.

Claims 29-37 all variously depend from claim 27 and are thus correspondingly non-obvious with respect to Ackley and Merritt; withdrawal of all pertinent obviousness rejections is requested.

Claim 16 is rejected under §103 as being obvious in view of the Ackley, Merritt, and Roulleau references. Claim 16 depends from allowable claim 12 and is thus correspondingly allowable. Further, Roulleau discloses a machine for printing a decorative motif on the shell of an uncooked poultry egg and does not remedy the deficiencies of Ackley and Merritt discussed hereinabove. Accordingly, withdrawal of the outstanding obviousness rejection of claim 16 is respectfully requested.

Claims 27-32 and 34-37 are rejected under §103(a) as being obvious in view of Egosi, Merritt, and Carlson. As mentioned, independent claim 27 essentially includes all of the limitations of allowable claim 12 and additional limitations. As discussed above, Egosi and Merritt fail to establish *prima facie* obviousness of claim 12, and thus correspondingly fail to render claim 27 obvious. The Carlson reference does not remedy the deficiencies of Egosi and Merritt. Specifically, Carlson discloses a method and apparatus for printing on a three dimensional article such as baseball bats and the like. Particularly, the reference focuses on techniques for printing on curved wood and metal surfaces. Col. 2, lines 49-60. Carlson does not teach or suggest providing an earplug, transferring the earplug, orienting the earplug, printing a pattern on the earplug, etc., as recited in claim 27. Carlson clearly does not even contemplate a process for printing on small, compressibly resilient items such as earplugs. Thus, Carlson does not teach or suggest the claimed limitations, nor remedy the deficiencies of Egosi and Merritt, nor is there a suggestion or motivation in Carlson or in the art to combine and modify the references as suggested by the Examiner, and, finally, there is no likelihood of success in forming the claimed invention through the proposed combination due to the shortfalls of all of the relied-upon references.

Accordingly, *prima facie* obviousness does not exist with respect to claim 27 concerning the Egosi, Merritt, and Carlson references; withdrawal of the outstanding obviousness rejection is requested. Claim 27 is not further rejected or objected to and is thus allowable to Applicants.



Claims 28-32 and 34-37 variously depend from allowable claim 27 and are thus correspondingly allowable; withdrawal of all relevant obviousness rejections is requested.

Finally, claims 38-39 are rejected as being obvious in view of Roulleau and Merritt. Independent claim 38 recites a process for forming a pattern on an earplug comprising, *inter alia*, printing a first pattern on a side surface of the earplug and printing a second pattern on an end surface of the earplug. For at least the reasons discussed above with respect to Roulleau and Merritt, these limitations are not taught or suggested by the references. Accordingly, *prima facie* obviousness is not established. Accordingly, claim 38 and claim 39 depending therefrom are non-obvious over Roulleau and Merritt; withdrawal of the referenced rejections is respectfully requested. Since claims 38-39 are not further rejected or objected to, these claims are allowable to Applicants.

Additionally, in support of the Applicants arguments for non-obviousness, attached at the ANNEX please find a Declaration submitted under 37 C.F.R. §1.132 which establishes objective evidence of commercial success of the claimed invention. The Declaration clearly establishes a nexus between the claimed invention and evidence of commercial success. Additionally, the evidence of commercial success presented in the Declaration is commensurate in scope with, and derives from, the claimed invention. Clearly, the Declaration further establishes the non-obviousness of the invention; entry and consideration hereof is respectfully requested.

In sum, the Examiner's proposed combinations of the relied-upon references fail to properly establish *prima facie* obviousness with respect to pending claims 12-39. Additionally, commercial success of the claimed invention has been properly established herein by presentation of objective evidence (see, attached Declaration).

Accordingly, claims 12-39 are non-obvious with respect to the relied-upon references and are thus allowable to Applicants; reconsideration and withdrawal of all outstanding rejections and allowance of the application are respectfully requested.

The Examiner is invited to contact Applicants' attorneys at the below-listed telephone number regarding this Supplemental Response or otherwise concerning the present application.

Applicants herein petition for any necessary extension of time required for entry and consideration of the present Supplemental Response.

The Commissioner is herein authorized to charge any required or outstanding fees regarding this Supplemental Response or otherwise concerning the present application to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

CANTOR COLBURN LLP

By: 

Daniel F. Drexler  
Registration No. 47,535  
CANTOR COLBURN LLP  
55 Griffin Road South  
Bloomfield, CT 06002  
Telephone: 860-286-2929  
Facsimile: 860-286-0115  
Customer No. 23413

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